

Application No. 10/561,622

Amendment dated April 1, 2009

Reply to Office Action of December 2, 2009

Docket No.: NY-KIT 404-US

REMARKS

Claims 11, 15, 16 and 19 have been rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Reissue Patent No. RE. 32,476 to Kistner (hereinafter "Kistner"). Claims 12-14, 17, 18, and 20-27 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kistner. Applicant respectfully traverses these rejections.

Of course, a rejection based on 35 U.S.C. § 102 requires that the cited reference disclose each and every element covered by the claim. *Electro Medical Systems S.A. v. Cooper Life Sciences Inc.*, 32 U.S.P.Q.2d 1017, 1019 (Fed. Cir. 1994); *Lewmar Marine Inc. v. Barent Inc.*, 3 U.S.P.Q.2d 1766, 1767-68 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 1007 (1988); *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir.), *cert. denied*, 484 U.S. 827 (1987). The Federal Circuit has mandated that 35 U.S.C. § 102 requires no less than "complete anticipation ... [a]nticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim." *Connell v. Sears, Roebuck & Co.*, 772 F.2d 1542, 1548, 220 U.S.P.Q. 193, 198 (Fed. Cir. 1983); *See also, Electro Medical Systems*, 32 U.S.P.Q. 2d at 1019; *Verdegaal Bros.*, 814 F.2d at 631. Here, the Examiner has failed to establish a *prima facie* case of anticipation because Kistner does not teach or suggest all of the limitations of pending claims 11-27.

Applicant respectfully submits that only the claimed invention teaches or suggests a plant cultivating substrate and a method of manufacturing same by reacting polyol with a water-retentive filling material, water and urethane prepolymer to form the claimed plant cultivating substrate. That is, the claimed invention adds polyol to the water-retentive filling material, water and urethane prepolymer to provide the claimed plant

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cultivating substrate with reduced hardness, improved shape retentivity or restorability and enhanced water absorptivity, as required in pending claims 11-27.

Whereas Kistner merely describes providing a potting medium by reacting water-retentive filling material, water and urethane prepolymer. Contrary to the Examiner's assertion, Kistner fails to teach or suggest reacting polyol with a water-retentive filling material, water and urethane prepolymer to provide the claimed plant cultivating substrate with reduced hardness, improved shape retentivity or restorability and enhanced water absorptivity, as required in pending claims 11-27. In fact, col. 2, lines 37-42 in Kistner, cited by the Examiner, merely describes preparing or making urethane prepolymer by reacting polyol with polyisocyanate. "To imbue one of ordinary skill in the art with knowledge of the present invention, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim of the insidious effect of hindsight syndrome, wherein that which only the inventor taught is used against the teacher." *W.L. Gore & Assoc. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983). The prior must to be judged based on a full and fair consideration of what that art teaches, not by using Applicant's invention as a blueprint for gathering various bits and modifying the pieces in an attempt to reconstruct Applicant's invention. The Examiner cannot simply contradict and/or modify the clear teaching of the reference to render the claims unpatentable. As noted herein, Kistner merely describes reacting polycol with polyisocyanate to make urethane prepolymer, one of the component of the claimed plant cultivating substrate.

Moreover, applicant respectfully notes that the Examiner's position untenable in light of recent Federal Circuit decision: "Because the hallmark of anticipation is prior invention, the prior art reference — in order to anticipate under 35 U.S.C. § 102 — must not only disclose all elements of the claim within the four corners of the document, but must also disclose those elements 'arranged as in the claim.'" *Net MoneyIN, Inc. v.*

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Verisign, Inc., 545 F.3d 1359 (Fed. Cir. 2008). Accordingly, contrary to the Examiner's assertion, Kistner does not anticipate nor render obvious pending claims 11-27 of the claimed invention.

Additionally, to establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, and not based on Appellant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. 2143.

As noted herein, Kistner is not suggestive of reacting polyol with a water-retentive filling material, water, urethane prepolymer to provide the claimed plant cultivating substrate with reduced hardness, improved shape retentivity or restorability and enhanced water absorptivity, as required in claims 11-27. Therefore, the Examiner has failed to establish a *prima facie* case of anticipation or obviousness because Kistner fails to teach or suggest all the limitations of claims 11-27. Accordingly, applicant respectfully requests these rejections be withdrawn.

Further, as admitted by the Examiner, Kistner fails to teach or suggest that the water-retentive filling material under dry conditions is from 15 to 60 wt.% of the plant cultivating substrate, as required in claims 12 and 21-27. In fact, col. 6, lines 25-33 in Kistner, cited by the Examiner, merely describes that the amount of prepolymer will be in range of about 1 to 40 weight percent, and preferably 3 to 20 weight percent of the aggregate material. Additionally, it is apparent from Example 3 in Kistner that the

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reaction to prepare the potting medium does not involve polyol, as suggested by the Examiner. Example 3 in Kistner merely shows reacting and mixing the water-retentive filling material, urethane prepolymer, acetone and water to prepare the potting medium. The ratio of the water-retentive filling material contained in the Kistner's potting medium is: $\{\text{amount of water-retentive filling material added} / (\text{amount of water-retentive filling material} + \text{amount of urethane prepolymer added})\} \times 100 = 260 / (260 + 40) \times 100 = 86.7$ weight %. Hence, the amount of urethane prepolymer relative to the water-retentive filling material has an upper limit in order to manufacture the plant cultivating substrate under the conditions determined in Kistner, which tends to increase the ratio of the water-retentive filling material contained. Accordingly, contrary to the Examiner's assertion, Kistner cannot adjust the ratio of the water-retentive filling material to 15 to 60 weight % as required in pending claims 12 and 21-27. The Examiner cannot simply contradict and/or modify the clear teaching of the reference to render the claims unpatentable. The Examiner cannot simply contradict and/or modify the clear teaching of the reference to render the claims unpatentable.

Furthermore, as noted herein, since Kistner does not teach adding polycol to the mixture to make the claimed plant cultivating substrate the claimed plant cultivating substrate with reduced hardness, improved shape retentivity or restorability and enhanced water absorptivity, it follows that Kistner does not teach or suggest that polyol is present in an amount 0.1 to 300 weight parts relative to 100 weight part of the water-retentive filling mater under dry conditions, as required in claim 14. As noted herein, col. 6, lines 27-30 in Kistner, cited by the Examiner, merely describes that the amount of prepolymer will be in range of about 1 to 40 weight percent, and preferably 3 to 20 weight percent of the aggregate material. The Examiner cannot simply contradict and/or modify the clear teaching of the reference to render the claims unpatentable. The

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Examiner cannot simply contradict and/or modify the clear teaching of the reference to render the claims unpatentable.

In view of the above, applicant believes the pending application is in condition for allowance.

* * *

Please charge the extension fee (\$130.00) to credit card. Attached is the PTO FORM PTO 2038. The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to our Deposit Account No. 50-0624, under Order No. NY-KIT 404-US (10513311) from which the undersigned is authorized to draw.

Dated: April 1, 2009

Respectfully submitted,

By 

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Attachments: Petition for Extension
PTO FORM 2038